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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/659,465 | 09/10/2003 | Edward J. Stashluk JR. | 067439.0141 | 5518 |

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| EXAMINER |
|---|
| RUHL, DENNIS WILLIAM |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3689 | |

| NOTIFICATION DATE | DELIVERY MODE |
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| 09/25/2008 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/659,465 | STASHLUK ET AL. | |
| | Examiner | Art Unit | |
| | Dennis Ruhl | 3689 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/31/03;7/2/04;9/14/07;11/2/07;1/8/08;2/8/08;5/30/08;7/11/08;* .
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-6,8-24, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to the claims, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter. The examiner does not consider that the recitation of a return label constitutes a tie to another statutory class.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 4, it is not clear as to what the scope of "conforms to the USPS merchandise return service specifications". There is no antecedent basis for “the USPS merchandise return service specifications”.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5,7-12,14-21,23, are rejected under 35 U.S.C. 102(e) as being anticipated by Hauser et al. (6536659).

For claims 1,3,20,21,23, Hauser discloses a method and system for enabling the return of products by sending a return to a return center (service provider). A customer is provided with a bar coded return label as claimed. See column 3, line 43 to column 4, line 35. The destination address is on the label as claimed. The label has bar coded data that is relevant to the return of the merchandise (identification of the transaction) and includes the merchant identification. Also, with respect to reciting what the data is that is on the label, unless the data is somehow used in a further method step of the claim in a functional manner, this is directed to non-functional descriptive material (in a similar sense to a printed matter issue for a return label as an article). The claim will not be rendered patentable by the mere recitation to non-functional descriptive material.

For claim 20, the recitation regarding the notification is directed to non-functional descriptive material. Unless the notification is acted upon in a further method step it will not serve as a limitation. Also in Hauser it is disclosed that the return label and the return can be pre-authorized.

For claim 2, this claim is directed to non-functional descriptive material. Reciting the name of the return provider is just descriptive language that does not serve as a further structural limitation.

For claim 4, as this claim is best understood by the examiner, the address on the return label complies with the USPS specifications; otherwise, the packages would never be able to be mailed.

For claim 5, see column 2, lines 17-23 where the claimed limitation is disclosed.

For claim 7, Hauser discloses that the return label can be received via email or via the Internet. See column 4, lines 30-35 and/or column 4, lines 1-15. When using email to receive a return label, this is using the Internet as claimed.

For claim 8, the scope of the claim is open to the data being just one of shipping origin or identification of the transaction. Hauser satisfies what is claimed due to the identification of the transaction being disclosed. Applicant has not further recited or narrowed the claim to require that the shipping origin be included on the return label.

For claim 9, see column 4, lines 16-35.

For claim 10, claiming that the data is RFID data is not a further recitation to structure or a method step. Data is data. The format the data is stored in can vary but

claim 10 is not reciting that there is an RFID tag or device, just that the data is RFID data. Hauser satisfies what is claimed.

For claims 11,14-19, this claim is directed to non-functional descriptive material. Also, with respect to reciting what the data is that is on the label, unless the data is somehow used in a further method step of the claim in a functional manner, this is directed to non-functional descriptive material (in a similar sense to a printed matter issue for a return label as an article). The claim will not be rendered patentable by the mere recitation to non-functional descriptive material.

For claim 12, this claim is also directed to non-functional descriptive material. This claim is just reciting a description of the destination. Unless the package is claimed as actually being shipped, this is non-functional descriptive material.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 6,22,24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (6536659).

For claim 6, not disclosed is that the return label is attached to an invoice. Hauser discloses that the return label can be included with the merchandise when it is initially purchased, see column 2. The minor difference of reciting that the return label is attached to an invoice is considered to be obvious to one of ordinary skill in the art. One of ordinary skill in the art would understand that the return label could simply be placed in the container that the merchandise is sold in, or can be attached to an invoice that would be included with the merchandise. It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the return label to an invoice. This involves no more than ordinary skill in the art.

For claim 22, the examiner takes official notice of the fact that it is known in the art of shipping that an item can be shipped and after shipping the shipping charges are assessed. This is known in the art as "reverse manifesting", where the shipping charges are assessed after the package has been received at its destination. It would have been obvious to one of ordinary skill in the art at the time the invention was made to assess shipping charges as claimed.

For claim 24, the machine readable data is used to determine if the merchant will accept the return after it has been received at the return center. After this determination is made, at some point it would have been obvious to one of ordinary skill in the art to

inform the customer of information regarding the return. This could be as simple as a notification to the customer that the items have been received.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (6536659) in view of Junger (6085172).

For claim 13, not disclosed is that the return provider maintains multiple return centers. Junger discloses a merchandise return system that has regional return centers that merchandise is returned to as opposed to having only one return center for the entire county. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have multiple return centers so that merchandise can be shipped to a regional return center that is closest to the customer.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689